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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,958	11/01/1999	FRANS EJNER RAVN HANSEN	12845.2USWO	7894

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EXAMINER

MERLINO, AMANDA H

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/403,958

Applicant(s)

HANSEN ET AL.

Examiner

Amanda H Merlino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 106-159 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 106-159 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 8-11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 151-152 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 151 and 152, "the ratio" lacks antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 142-150, 153, 155-159 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kosaka (5,457,526).

Kosaka teaches of an apparatus for analyzing particles in a liquid sample comprising a sample compartment (16) containing a volume of liquid sample wherein light is transmitted through the sample compartment (16) and is detected by an array of active detection elements (24) wherein the sample compartment (16) has a wall part allowing electromagnetic signals from the sample in the compartment to pass through the wall after passing through a focusing lens (86) and a processor for processing the intensities detected by the detection elements.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 151-152 and 154 rejected under 35 U.S.C. 103(a) as being unpatentable over Kosaka (5,457,526).

Kosaka teaches of an apparatus for analyzing particles in a liquid sample comprising a sample compartment (16) containing a volume of liquid sample wherein light is transmitted through the sample compartment (16) and is detected by an array of active detection elements (24) wherein the sample compartment (16) has a wall part allowing electromagnetic signals from the sample in the compartment to pass through the wall after passing through a focusing lens (86) and a processor for processing the intensities detected by the detection elements.

Kosaka lacks the teaching of the range of the ratio and the average thickness of the interior of the compartment.

With regard to claim 154 (the average thickness of the interior of the compartment), it should be noted that varying the sizes, proportions, and etc. is not considered **novel** (see In re Rose, 105 U.S.P.Q. 237; In re Aller et al., 105 U.S.P.Q. 233; In re Dailey et al., 149 U.S.P.Q. 47; In re Reese, 129 U.S.P.Q. 402; In re Gibson, 45 U.S.P.Q. 230). It would have been an obvious expedient for one with ordinary skill in the art to reconfigure the thickness of the wall to achieve a more accurate measurement.

With regard to claims 151-152 (range of the ratio), it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the range of ratios

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since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 106-141 rejected under 35 U.S.C. 103(a) as being unpatentable over Brule et al (GB 2 152 660 A).

Brule et al teach of a method for analysis of biological products comprising the steps of illuminating a sample compartment containing a volume of liquid sample wherein light is transmitted through the sample compartment and is detected by an array of active detection and a processor for processing the intensities detected by the detection elements wherein the images are divided into sub area and the sub areas are processed accordingly.

With regard to the range of the ratio of the images, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the range of ratios since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Conclusion

Papers related to the application may be submitted to Group 2800 by Fax transmission. Papers should be faxed to Group 2800 via the PTO Fax Machine located in Crystal Plaza 4. The form of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine number is:

703-308-7722

If the applicant wishes to send a Fax dealing with a Proposed Amendment for discussion for a phone interview then the fax should:

- 1) Contain either the statement "DRAFT" or "PROPOSED AMENDMENT" on the Fax Cover Sheet; and
- 2) Should be unsigned by the attorney or agent.

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This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Examiner Amanda H. Merlino* whose telephone number is (703) 305-3488. The examiner can be reached on Mondays and Thursdays only.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-0956.

Amanda H. Merlino *ahm*
Patent Examiner
Art Unit 2877
December 9, 2002/ahm

Frank G. Font
FRANK G. FONT
SUPERVISORY PATENT
EXAMINER